

## REMARKS

### A. Background

Claims 1-36 were pending in the application at the time of the Office Action, with claims 31-34 having been previously withdrawn from consideration.<sup>1</sup> The Office Action rejected claims 1-4, 9-13, 16-19, 24, 25, 27, and 28 as being anticipated over cited prior art, and claims 5-8, 14, 15, 20-23, 26, 29, and 30 were rejected as being obvious over cited prior art. By this response applicant has amended claims 1, 16, and 24. As such, claims 1-30 and 35-36 are presented for the Examiner's consideration in light of the following remarks.

### B. Consideration of IDS

On September 21, 2004, a supplemental information disclosure statement was filed in the present application. The PAIR system of the United States Patent and Trademark Office. Acknowledges receipt of the supplemental IDS. The applicant, however, has not yet received an initialed copy of the 1449 that was submitted with the supplemental IDS. As such, attached please find a copy of the previously submitted 1449. Applicant respectfully requests that the examiner initial consideration of the references cited thereon and return a copy to the applicant.

### C. Proposed Claim Amendments

By this response applicant has amended claims 1, 16, and 24. These claims have been amended to simply clarify that the packet protocol session is only between the mobile communication station and the network server and are supported by the prior claim language. Accordingly, Applicant submits that because all of the claim amendments are supported by prior

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<sup>1</sup> Although the current Office Action only acknowledges claims 1-34, claims 35 and 36 were also submitted in the response to the previous Office Action and are thus currently pending.

pending claim language, the claim amendments do not add new matter and do not raise any new issues which would require a further search. As such, entry of the amendments is respectfully requested.

D. Rejection on the Merits

Paragraph 1 of the Office Action rejected claims 1-4, 9-13, 16-19, 24, 25, 27, and 28 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,205,330 to Winbladh. Of these, claims 1, 16, and 24 are independent claims. Paragraph 2 of the Office Action rejected claims 5-8, 14, 15, 20-23, 26, 29, and 30 under 35 U.S.C. §103(a) as being unpatentable over Winbladh in view of U.S. Patent No. 6,636,502 to Lager et al.<sup>2</sup>

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131. That is, "for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly." MPEP § 706.02. Applicant also notes that "[i]n determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure.'" MPEP § 2121.01. In other words, a cited reference must be enabled with respect to each claim limitation. During examination, the pending claims are given their broadest reasonable interpretation, *i.e.*, they are interpreted as broadly as their terms reasonably allow, consistent with the specification. MPEP §§ 2111 & 2111.01.

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<sup>2</sup>Although the prior art status of the cited art is not being challenged at this time, Applicants reserve the right to do so in the future. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status or asserted teachings of the cited art.

Winbaldh discloses that when an email arrives, host arrangement 11 creates an SMS (short message service) message and sends the SMS message to an MS (mobile station) unit (e.g., one with a display that is only able to accommodate a limited number of characters at a time). Col. 1, lines 20-29; col. 7, lines 6-8. The SMS message includes an application prefix (e.g., email), an email notification 45, and an agent part that includes a "Job\_id" field corresponding to the email stored on the server 11, a "Code" field with a password for downloading the "Job\_id" email, and a "DSG address (Data SMS Gateway Address)" field containing the address and/or telephone number of the server 11 where the email is stored. Col. 7, lines 8-35. The SMS message is stored in the MS unit (often a cellular telephone), where communication software 46 in a computer 22 can read the notification information 45. Col. 7, lines 36-42 and Figure 2.

By connecting the MS unit to a computer 22, with the communication software 46, the SMS messages stored in the MS unit (20) may be read and transferred to the appropriate application software 49 in computer 22. Col. 7, lines 38-42. Computer 22 displays notification information and specific commands, such as "Get Now," "Get Later," and "Delete Mail." Then, when the "Get Now" function is activated, for example, the communications software 46 reads the agent part of the SMS message and executes the following procedures: (1) calls the number in the "DSG address" 47 to start a session; (2) transfers the "Job\_id" and "Code" to the server 11, which then transmits the email; and (3) releases the transmitting part of the session when transmission is terminated. Col. 7, line 58 – col. 8, line 2.

As shown in Figure 2, the host arrangement 11 is connected to the internet 10, an SMS center and a Mobile Switching Center (MSC). The host arrangement 11 communicates with the SMS center via an X.25 connection and with the MSC via modem 24. Although Winbladh discloses the use of packet data connections, they are disclosed only in relation to the fixed network. The only packet data sessions described in the Winbladh patent are i) a TCP/IP connection between the

Internet and the host arrangement over which e-mails are received for storage by the host arrangement (see col. 4, lines 7-13) and ii) an X.25 communication between the host arrangement 11 and the SMS center (see col.6, lines 32-34).

Noticeably, no packet data sessions are described or disclosed for communication to or from the mobile station 20 or the computer unit 22. Instead, the Winbladh patent teaches that an MS unit receives an SMS message with a field “Data SMS Gateway Address” containing the address and/or telephone number of the server 11” in which an e-mail to be accessed is stored (col. 7, lines 6-7 and 33-35). The MS unit calls the number in the DSG address for starting a session, after which the server commences transmission of data in the same session (col.7, lines 58-67).

The Office Action asserts that “call[ing] the number in the ‘DSG address’ 47” equates to i) the step of “establishing … a packet data protocol session,” as recited in claim 1, ii) “means for establishing a packet data protocol session,” as recited in claim 16, and iii) a program storage device containing instructions to “establish a packet data protocol session,” as recited in claim 24. While it is true that calling a number may establish a session, and that an address may be needed to establish this session with a server, this does not equate to establishing a “packet data protocol” session, as discussed below.

As shown in Figure 1 of the Winbladh patent, there is a “Data Connection” between the “Host Means” and the “Computer Unit.” In August 1996, when the Winbladh patent was filed, cellular telephone networks, including GSM systems, were designed solely for circuit switched connections. These circuit switched connections use various standards. For instance, data connections have been implemented using Circuit Switched Data (CSD). This later developed to the well known High Speed Circuit Switched Data (HSCSD) standard, which uses several time slots in the same frame to convey the data. In the Enhanced Data-Rates for GSM Evolution (EDGE) standard, which is another circuit switching protocol, an enhanced version of HSCSD known as

Enhanced Circuit Switched Data (ECSD) has a bandwidth that has been increased to 384 Kbps by allowing the use of eight timeslots of the same frame to convey data. All of these standards transfer data over wireless cellular telephone networks without using packet data connections.

Because the state of the art at the time of filing of the Winbladh patent was to use circuit switching, the connections of the Winbladh patent are directed to circuit switched connections. To be directed to packet data communications, the Winbladh patent would have had to specifically point out otherwise, which it does not do. There is absolutely no indication whatsoever in the Winbladh patent of any packet data connection between the host means 11 and the mobile station 20 or the computer unit 22. In addition, there are no examples of how to implement such a packet data connection in the Winbladh patent because such packet data connections in GSM networks did not exist at the time of filing the Winbladh patent. Thus, a skilled person in the art could not have envisaged the use of a packet data connection between the "host means" and the "computer unit" according to the Winbladh patent.

The Examiner appears to consider the term "address" in the expression "DSG address... containing the address and/or telephone number" of Winbladh to implicate a packet data protocol address. However, in Winbladh the use of the term "address" does not implicate the use of a packet data connection but only a general connection. Given the fact that Winbladh does not disclose any use of a packet data connection to or from the MS unit 20 or the computer unit 22, but only indicates circuit switched connections, one of ordinary skill in the art would interpret the term "address" as a general term for an address to be used for a circuit switched connection.

In contrast to Winbladh, which is directed to enabling receipt of longer text messages than SMS message lengths to mobile telephone subscribers (see Col. 1 lines 52-56 of Winbladh), the claimed invention is directed to reducing work load for a repository handling packet data addressing for a mobile communication unit when pushing packet data from a network server to the mobile

communication unit. These are two completely different purposes having different requirements. To accomplish Winbladh's goals, a circuit switched connection is adequate and would have been used at the time of filing of the Winbladh patent, providing all the functionality required. Packet data protocol sessions are not required to or from the Winbladh mobile station, and since the Winbladh patent makes no mention of packet data protocol sessions, there would have been no motivation to use packet data protocol sessions. In contrast, to accomplish the goals of the current invention packet data protocol sessions are necessary. One method of providing packet data is to use GPRS (General Packet Radio Service), which in recent years has been developed to provide Mobile Stations in GSM networks with packet data. Because GPRS is a packet-switching service, it cannot be used with circuit switched data.

In conclusion, to a skilled person in the art, the Winbladh patent teaches a circuit switched data connection between a server and a computer unit connected to a mobile station, not a packet switched data connection between a server and a mobile station. Thus, because circuit switched connections do not facilitate packet data protocol sessions, the Winbladh patent does not teach or suggest a method for initiating immediate transfer of packet data from a network server to a mobile communication station over a digital radio communication network, which includes

establishing, by the application of the mobile communication station having a second packet data network address, a packet data protocol session between said mobile communication station and said network server using said first packet data network address,

whereby the network server is able to transfer packet data to the mobile communication station and the application using said packet data protocol session,

as recited in claim 1, or a system at a mobile communication station for facilitating immediate transfer of packet data from a network server to a mobile communication station over a digital radio communication network, which includes "packet data protocol means for establishing a

**packet data protocol session between said mobile communication station and said network**

server," as recited in claim 16, or a program storage device containing instructions

causing the mobile communication station, to which a second packet data network address is allocated, to establish a packet data protocol session between said mobile communication station and said network server using said first packet data network address; and

causing the mobile communication station to receive packet data, addressed to the second packet data network address, from the network server via said packet data protocol session.

as recited in claim 24.

Claims 2-15 and 35 depend from claim 1; claims 17-23 and 36 depend from claim 16; and claims 25-30 depend from claim 24. These dependent claims incorporate the limitations of their corresponding independent claims. As such, applicant submits that claims 2-15 and 35, 17-23 and 36, and 25-30 are distinguished over the cited art for at least the same reasons as discussed above with regard to claims 1, 16, and 24.

Paragraph 2 of the Office Action rejected claims 5-8, 14, 15, 20-23, 26, 29, and 30 under 35 U.S.C. §103(a) as being unpatentable over the Winbladh patent in view of U.S. Patent No. 6,636,502 to Lager et al. Specifically, the Office Action asserts that the Winbladh patent discloses the claimed invention except that Winbladh "does not disclose that the attach is a GPRS attach." The Office Action further asserts that "it would have been obvious to incorporate the GPRS into the GSM system taught by Winbladh."

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation . . . to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2143.

As mentioned above, the reason the Winbladh patent did not disclose "performing a GPRS attach" is that the Winbladh patent was directed to circuit switched data, not packet switched data. Because circuit switched data is technologically completely different than packet switched data, and GPRS is only used with packet switched data, there would be no incentive to combine the teachings of Lager with the teachings of Winbladh. Thus, it would not have been obvious at the time of the claimed invention to use GPRS of Lager with the circuit switched data of Winbladh. Even if, *arguendo*, the teachings were combined, the combination of the Winbladh patent and the Lager patent would not disclose all of the elements of the claimed invention, as Lager does not cure the deficiencies of Winbladh, described above. As such, Applicant respectfully submits that claims 5-8, 14, 15, 20-23, 26, 29, and 30 are not obvious over the Winbladh patent in view of the Lager patent.

E. Conclusion

Applicant notes that this response does not discuss every reason why the claims of the present application are distinguished over the cited prior art. Most notably, applicant submits that many if not all of the dependent claims are independently distinguishable over the cited prior art. Applicant has merely submitted those arguments which it considers sufficient to clearly distinguish the claims over the cited prior art.

In view of the foregoing, applicant respectfully requests the Examiner's reconsideration and allowance of claims 1-30 and 35-36 as amended and presented herein.

In the event there remains any impediment to allowance of the claims which could be clarified in a telephone interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

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Dated this 26 day of September 2005.

Respectfully submitted,



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